

REMARKS

This communication is a full and timely response to the aforementioned non-final Office Action dated December 29, 2005. By this communication, claims 2-8 and 10-18 have been amended. Claims 1-18 are pending.

Information Disclosure Statement

The Office Action states that JP 2001-524237, submitted with the IDS filed November 4, 2003, has not been considered because no translation was provided. It is to be noted that US Patent No. 6014688, also submitted with that IDS, is the US counterpart to the Japanese application. Since that reference was considered by the Examiner, the record reflects that the substance of the Japanese reference has been considered.

Objections to the Oath/Declaration

The Oath/Declaration was objected to for allegedly failing to properly identify the residence and post office address of each inventor. Applicant respectfully traverses this objection.

On page 3 of Applicant's Combined Declaration, the inventor's residence is identified as San Jose, California, USA. The inventor's post office address is identified as its business address, which is located in Osaka, Japan. As stated in MPEP §605.02, Applicant's place of residence is identified by city and either state or foreign country. Based on accepted practice, Applicant's provided residence of San Jose, California, USA, is proper and complies with the provisions of 37 CFR §1.63.

Under current US patent practice, the post office address is equivalent to Applicant's mailing address. See 37 CFR §1.63. The mailing address is the address

at which Applicant customarily receives mail, and an acceptable mailing address is identified as being Applicant's home or business address. For at least this reason, Applicant's use of a business address as the mailing address complies with the requirements of the Oath/Declaration under 37 CFR §1.63, and Applicant requests that the objection to the Oath be withdrawn.

Rejections Under 35 U.S.C. §101

Claims 14-18 were rejected under 35 U.S.C. §101 because the claimed invention is allegedly directed to non-statutory subject matter. Applicant respectfully traverses this rejection. However, in an effort to expedite prosecution, Applicant has amended claims 14-18 in a manner that addresses the Examiner's concerns. Accordingly, Applicant requests that the rejection of claims 14-18 under 35 U.S.C. §101 be withdrawn.

Rejections Under 35 U.S.C. § 103

Claims 1-18 were rejected under 35 U.S.C. §103(a) as unpatentable over *Bloomfield* (U.S. Patent No. 6,023,345) in view of *Gordon et al* (U.S. Patent No. 5,291,302) and in further view of *Okada et al* (U.S. Patent No. 6,876,462). Applicant respectfully traverses this rejection.

Independent claims 1, 9, and 14 similarly recite, among other elements, sending to a recipient via email a tool program by which to obtain the data stored in the prescribed storage area.

Bloomfield discloses a fax to email communication system that sends a hard copy document to a fax device through an electronic mail data network. The hard copy is delivered such that it can be retrieved by a recipient and an email device in

the ordinary course of retrieving the email, and displayed on the screen of the email device. *See Abstract*. The Examiner acknowledges that Bloomfield fails to teach or suggest a data forwarding unit for forwarding data to a prescribed storage area and a controller as recited in the independent claims. The Examiner relies on Gordon and Okada to remedy these deficiencies.

Gordon, applied to allegedly teach a data forwarding unit, discloses a facsimile telecommunications system and method whereby an originating machine transmits faxed document image data to a receiving machine and the receiving machine stores the faxed format and the document image on a mass storage device 67. The Examiner acknowledges that *Gordon* fails to teach or suggest at least sending a tool program as recited in independent claims 1, 9, and 14.

Okada discloses a network printer having a LAN interface section 7 that executes procedures necessary for acquiring facsimile data from a LAN. In this process, after data is received a CPU 1 identifies notification email address from the data and registers the notification email address in a Table 10 provided in RAM 3. A format converter 4 then converts image data received through the email via the LAN to a G3 facsimile format. The received facsimile data is temporarily stored in a facsimile data storage section 5. A facsimile section 6 performs transmission and reception processing of facsimile data. A modem 8 then performs modulation or demodulation necessary to transmit or receive the facsimile data and a network control unit 9 controls the line. The Examiner alleges that through these processes *Okada* controls an email transmission unit to send a tool program, as recited in the claims. Applicant submits, however, that *Okada* fails to teach or suggest the use of a program that enables data to be obtained from a storage area. Without a teaching

or discussion as such, *Okada* fails to remedy the deficiencies of both *Bloomfield* and *Gordon*.

In summary, *Bloomfield*, *Gordon*, and *Okada* either singly or combined fail to disclose or suggest sending to a recipient via email a tool program by which to obtain the data stored in a prescribed storage area, as recited in independent claims 1, 9, and 14. For at least these reasons, a *prima facie* case of obviousness has not been established.

To establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, obviousness "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys. V. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). For at least the above reasons, Applicant requests that the rejection of claims 1, 9, and 14 under 35 U.S.C. §103 be withdrawn, and these claims be allowed.

Claims 2-8 depend from claim 1, claims 10-13 depend from claim 9, and claims 15-18 depend from claim 14. By virtue of these dependencies, Applicant submits that claims 2-8, 10-13, and 15-18 are allowable for at least the same reasons given above with regard to their respective base claims. In addition, Applicant submits that these claims are further distinguishable over *Bloomfield*, *Gordon*, and *Okada* by the additional elements recited therein. Applicant requests, therefore, that the rejection of claims 2-8, 10-17, and 15-18 under 35 U.S.C. §103 be withdrawn, and these claims be allowed.

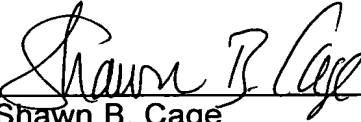
Conclusion

Based on at least the foregoing amendments and remarks, Applicant submits that claims 1-18 are allowable, and this application is in condition for allowance. Accordingly, Applicant requests a favorable examination and consideration of the instant application. In the event the instant application can be placed in even better form, Applicant requests that the undersigned attorney be contacted at the number below.

Respectfully submitted,

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